

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--------------------------------------|---|----------------------------|
| In re application of: Dolph          | § |                            |
|                                      | § | Group Art Unit: 2621       |
| Serial No.: 10/803,631               | § |                            |
|                                      | § | Examiner: Tekle, Daniel T. |
| Filed: March 18, 2004                | § |                            |
|                                      | § | Confirmation No.: 5810     |
| For: Targeted Marketing Overlays for | § |                            |
| Digital Video Recorders              | § |                            |

37945

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**APPEAL BRIEF (37 C.F.R. 41.37)**

This brief is in furtherance of the Notice of Reinstatement of Appeal, filed in this case on June 30, 2010.

No fees are believed to be necessary. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0457.

### **REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

### **RELATED APPEALS AND INTERFERENCES**

This appeal has no related proceedings or interferences.

## **STATUS OF CLAIMS**

**A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

The claims in the application are: 1-22

**B. STATUS OF ALL THE CLAIMS IN APPLICATION**

Claims canceled: 23

Claims withdrawn from consideration but not canceled: None

Claims pending: 1-22

Claims allowed: None

Claims rejected: 1-22

Claims objected to: None

**C. CLAIMS ON APPEAL**

The claims on appeal are: 1-22

### **STATUS OF AMENDMENTS**

An Amendment to the Final Office Action of April 2, 2010, was not filed. Accordingly, the claims on appeal herein are as amended in the Amendment to Office Action filed on December 16, 2009.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

### **A. CLAIM 1 - INDEPENDENT**

The subject matter of claim 1 is directed to a method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) (Figure 1, 95, Figure 2, 130) comprising: sending, by a processor of a service provider (Figure 3, 300, Figure 5, 310), a television program containing the original marketing content from the service provider, to a DVR (Figure 5, 310, [0037] line 1-59); receiving, by the processor, a user ID (Figure 5, 304) and a program ID (Figure 5, 304) from the DVR (Figure 5, Figure 2); and responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID (Figure 5, 306; [0031], lines 5-8, [0033]), and sending by the processor, a local marketing content to the DVR (Figure 5, 310), wherein the local marketing content is based on the location of the user and the program ID (Figure 3, 160, [0038], lines 7-9).

### **B. CLAIM 6 - INDEPENDENT**

The subject matter of claim 6 is directed to a method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) (Figure 1, 95, Figure 2, 130) comprising: responsive to a processor of the DVR storing a television program having the marketing content, in the memory, sending, by the processor of the DVR, a user ID and a program ID to a service provider (Figure 5, 310, [0037] line 1-59); responsive to receiving, by the processor, a local marketing content from a service provider in response to sending the user ID and the program ID (Figure 5, 306; [0031], lines 5-8, [0033]), replacing the marketing content with the local marketing content in the memory (Figure 3, 160, [0038], lines 7-9).

**C. CLAIM 12 - INDEPENDENT**

The subject matter of claim 12 is directed to an apparatus, comprising: a Digital Video Recorder (DVR) connected to a network; a storage medium in the DVR (Figure 1, 95, Figure 2, 130); a plurality of instructions stored in the storage medium (Figure 2, 100), configured to run on a processor of the DVR (Figure 2, 106) to perform actions comprising: receiving a television program containing an original marketing content from a the service provider (Figure 4, 204); storing the television program in the memory (Figure 2, 110); responsive to the processor storing the television program in the memory, sending, by the processor, a user ID and a program ID to the service provider (Figure 4, 206); responsive to receiving a local marketing content from the service provider at DVR (Figure 4, 204), creating a modified marketing content by modifying the original marketing with the local marketing content (Figure 4, 216-220), wherein the local marketing content is selected based on a location of the user determined by referencing a user profile associated with the user ID and on the program ID (Figure 5, 306; [0031], lines 5-8, [0033]); and displaying the television program with the modified marketing content upon a user request (Figure 4, 222).

**D. CLAIM 17 - INDEPENDENT**

The subject matter of claim 17 is directed to an apparatus, comprising: a processor of a service provider connected to a network; a storage medium connected to the processor (Figure 1, 95, Figure 2, 130); a plurality of instructions stored in the storage medium (Figure 2, 100), the plurality of instructions configured to run on the processor to perform actions: receiving a user ID (Figure 5, 304) and a program ID (Figure 5, 304) from a DVR(Figure 5, Figure 2), wherein the user ID and the program ID are sent by the DVR to the processor when the DVR receives a television program (Figure 4, 204) and stores the television program in a memory of the DVR (Figure 2, 110); determining, by the processor, a location of a user based on a user profile associated with the user ID; determining (Figure 5, 306; [0031]), by the processor, whether a local marketing content exists for the television program based on the program ID and the user profile (Figure 5, 308); and responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR (Figure 5, 310).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to review on appeal are as follows:

### **A. GROUND OF REJECTION 1 (Claims 1-22)**

The Examiner has rejected claims 1-22 under 35 U.S.C. § 103 as being unpatentable over Freeman et al., U.S. Patent Application Publication No. 2001/0013123 (hereinafter “Freeman”), in view of Franco, U.S. Patent Application Publication No. 2002/0046407 (hereinafter “Franco”). Final Office Action dated April 2, 2010, pp. 2-4.



## ARGUMENT

### **A. GROUND OF REJECTION 1 (Claims 1-22)**

The Examiner has rejected claims 1-22 under 35 U.S.C. § 103 as being unpatentable over Freeman et al., U.S. Patent Application Publication No. 2001/0013123 (hereinafter “Freeman”), in view of Franco, U.S. Patent Application Publication No. 2002/0046407 (hereinafter “Franco”). Final Office Action dated April 2, 2010, pp. 2-4.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

#### **1. Claim 1**

Claim 1 recites:

A method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:  
    sending, by a processor of a service provider, a television program containing the original marketing content from the service provider, to a DVR;  
    receiving, by the processor, a user ID and a program ID from the DVR;  
and  
    responsive to receiving the user ID and the program ID at the processor,

determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program ID.

Appellant submits that the cited art, individually or in combination, fails to teach or disclose the element “responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program ID.”

In rejecting claim 1, the Examiner states:

Regarding Claim 1: Freeman et al and Franco discloses a method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising: sending, by a processor of a service provider (paragraph 0079 of Freeman et al.), a television program containing the original marketing content from the service provider (paragraph 0027 and 0031 of Freeman et al.), to a DVR (paragraph 0090 of Franco); receiving, by the processor (paragraph 0021 of Franco), a user ID (paragraph 0068 of Franco) and a program ID (paragraph 0041 and 0064 of Freeman et al.) from the DVR (paragraph 0090 of Franco); and responsive to receiving the user ID (paragraph 0021 and 0068 of Franco) and the program ID (paragraph 0041 and 0064 of Freeman et al.) at the processor (paragraph 0021 Freeman et al.), determining, by the processor, a location of the user by referencing a user profile (paragraph 0081 of Freeman et al.) associated with the user ID (paragraph 0021 and 68 of Franco), and sending by the processor, a local marketing content to the OVR (paragraph 0090 of Franco), wherein the local marketing content is based on the location of the user and the program ID (paragraph 0041 and 0081 of Freeman et al.).

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franco invention into of Freeman et al. invention in order to store a user requested program at the user station. Regarding Claim 2: Freeman et al and Franco discloses a method of claim 1 further comprising: determining whether no local marketing content exists for the television program (paragraph 0033 of Freeman et al.); and responsive to a determination that the no local marketing content exists for the television program (paragraph 0028 of Freeman et al.), sending a message indicating that no local marketing content exists for the television program (paragraph 0028 of Freeman et al.) to the OVR (paragraph 0090 of Franco).

Final Office Action dated April 2, 2010, pp. 2-4.

The Examiner cites the following paragraphs Freeman [0041] and [0081] and Franco [0090] to disclose the above limitation.

Freeman, paragraph [0081] discloses providing “information about the users in order to more accurately provided appropriate and desired customized programming, that such information could be a simple as geographic location, which may also provide some demographic overtones” and providing “particular programming (e.g., pay-per-view-programming) directly to individual users, as well as collect more extensive information about them.” The evidence shows that Freeman does not disclose obtaining the geographic location from a user profile and the user ID.

Franco, paragraph [0021] discloses that a “server can also be configured to provide programming data to the recording module, wherein programming data are based at least upon the programming instruction, and wherein the programming data identify the broadcast content.” The evidence shows that Franco does not teach or suggest using a program ID in conjunction with a user ID as stated in the claims.

Franco, paragraph [0068] discloses a “Login Page 200, which prompts a user for identification information 202, such as a user ID, and authentication information 204, such as a password.” The evidence shows that the user ID in Franco is not used in the same way as in Appellant’s claims because Franco is directed only to logging in and no other actions while Appellant’s claim 1 is directed to “local marketing content” that is “based on the location of the user and the program ID.” In the claim, the user ID is used to determine a location of the user. The combination of Franco and Freeman fails to disclose using the user ID to determine a location of the user and then to determine “local marketing content.”

In addition, although Freeman may have some similar appearances to portions of Claim 1, this similar appearance is due only to Freeman’s teaching of a system for creating targeted content for an identified user. Freeman’s method of operation is quite different from the operation of Claim 1. Freeman is different because Freeman uses a hub and spoke system. In the hub and spoke system of Freeman, all of the processing work is performed at the hub (see Freeman Abstract, Summary of the Invention, and paragraph [0027]). In contradistinction, Claim 1 divides the work between the service provider and the DVR. But the division of work is not the only reason that Claim 1 is novel. Claim 1 is novel because the service provider distributes

the local marketing content only upon a request from a DVR which has recorded a program and sent a user ID and a program ID to the service provider. Only then does the service provider send to the DVR targeted content for the user and for the program that was recorded.

Correspondingly, in Claim 6, the DVR does not receive marketing content until the DVR has sent out a user ID and a program ID, and that takes place after recording a program. This feature occurs automatically or “responsive to” storing the program in the DVR.

Franco does not remedy any of the deficiencies of Freeman. Franco teaches one or more systems for remotely programming a DVR from a computer over a network. Appellant believes that the Examiner combines Freeman and Franco only in order to add the user ID to Freeman. Applicant’s understanding of the Examiner’s reasoning is based on the Examiner’s statement that:

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franco invention into of Freeman et al. invention in order to store a user requested program at the user station.

Appellant disagrees with the Examiner’s reasoning. Freeman is only concerned with creating and distributing enhanced content for the users of a service provider. Appellant can see no basis for introducing the additional feature of a remote user logging into a web site to remotely control his DVR other than the patent mentions a user ID. However, Freeman is silent in regard to remote operation of the DVR. Freeman has a recording feature. Freeman does not have a remote capability. Indeed no remote capability is required in Freeman because the DVR / Receiver is local to the user and therefore no remote login to the DVR of Freeman is required. In addition, Claim 1 does not recite remote operation. In Claim 1 and Claim 6 a user ID and a program ID are provided by the DVR to the service provider for the explicit purpose of requesting additional content from the service provider.

Assuming *arguendo* that Freeman and Franco could be combined by re-engineering Freeman’s receiver and service provider to support Franco’s features. The combined invention would still not teach the claim elements of the Appellant. Specifically, in such a case, the request to record the video would come from a remote computer using Franco’s user ID, and then Freeman’s service provider would receive the request and distribute the custom program to the user’s DVR. Such a merger of the inventions of Freeman and Franco would still fail to teach the

novel aspect of Claim 1 as discussed above because the combination is silent in regard to the DVR sending a request when it stores a program, and the service provider sending local marketing content based on a user location and program ID.

## **2. Claim 2**

Claim 2 recites:

The method of claim 1 further comprising:  
determining whether no local marketing content exists for the television program; and  
responsive to a determination that no local marketing content exists for the television program, sending a message indicating that no local marketing content exists for the television program to the DVR.

The Examiner cited Freeman [0033] to disclose “determining whether no local marketing content exists for the television program.” Paragraph [0033] discloses “customized programming” that may be “tailored to each user.” However, the reference is cited to the specific limitation as claimed.

The Examiner cited Freeman [0028] to disclose “responsive to a determination that no local marketing content exists for the television program.” Freeman [0028] discloses selective storing of customized programming. However, Freeman [0028] is silent in regard to a “determination that no local marketing content exists for the television program.”

The Examiner cited Freeman [0028] and Franco [0090] to disclose “sending a message indicating that no local marketing content exists for the television program to the DVR.” Franco [0090] is cited to disclose a DVR. The combination of Franco and Freeman is silent in regard to sending message indicating that no local marketing content exists for the television program because, as stated above, Freeman [0028] is silent in regard to a “determination that no local marketing content exists for the television program” and therefore, the combined art cannot disclose the element of the claim.

## **3. Claim 6**

Claim 6 recites:

A method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:  
responsive to a processor of the DVR storing a television program having

the marketing content, in the memory, sending, by the processor of the DVR, a user ID and a program ID to a service provider;

responsive to receiving, by the processor, a local marketing content from a service provider in response to sending the user ID and the program ID, replacing the marketing content with the local marketing content in the memory

Appellant submits that the cited art, individually or in combination, fails to teach or disclose the element “responsive to receiving, by the processor, a local marketing content from a service provider in response to sending the user ID and the program ID, replacing the marketing content with the local marketing content in the memory.”

In rejecting claim 6, the Examiner states:

Regarding Claim 6: Freeman et al and Franco discloses a method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) comprising: responsive to receiving, by the processor (paragraph 0021 of Freeman et al.), a local marketing content from a service provider (paragraph 0018 of Freeman et al.) in response to sending the user ID (paragraph 0021 and 68 of Franco) and the program ID (paragraph 0041 and 0064 of Freeman et al.), replacing the marketing content with the local marketing content in the memory (paragraph 0073 and 0090 of Freeman et al.)

First the cited art is silent in regard to the following limitation: “responsive to a processor of the DVR storing a television program having the marketing content, in the memory, sending, by a processor of the DVR, a user ID and a program ID to a service provider.” The user ID and the program ID are sent when the processor stores the television program. Thus, when a television program is received and stored, the IDs are sent automatically (“responsive to”) to the service provider. This feature is not found in any of the cited art, nor can it be carried out by a combination of any of the cited art.

The cited art does not disclose the foregoing features. Freeman teaches (1) sending all content all the time to all receivers, and letting the receivers tailor the viewed program by selecting the desired segments, and (2) sending generic content to the all receivers and additionally sending user targeted content. However, Freeman does not teach the elements and cooperation of the elements of amended claim 1 and amended claim 6. None of the other art in combination with Freeman remedies this deficiency.

As explained above, although Freeman may have some similar appearance to portions of Claim 6, this similar appearance is due only to Freeman's teaching of a system for creating targeted content for an identified user. Freeman's method of operation is quite different from Claim 6. Freeman is different because Freeman uses a hub and spoke system. In the hub and spoke system of Freeman, all of the processing work is performed at the hub (see Freeman Abstract, Summary of the Invention, and paragraph [0027]). In contradistinction, Claim 6 divides the work between the service provider and the DVR. But the division of work is not the only reason that Claim 6 is novel. Claim 6 is novel because the service provider distributes the local marketing content only upon a request from a DVR which has recorded a program and sent a user ID and a program ID to the service provider. Only then does the service provider send to the DVR targeted content for the user and for the program that was recorded. Correspondingly, in Claim 6, the DVR does not receive marketing content until the DVR has sent out a user ID and a program ID, and that takes place after recording a program. This feature occurs automatically or "responsive to" storing the program in the DVR.

Franco does not remedy any of the deficiencies of Freeman. Franco teaches one or more systems for remotely programming a DVR from a computer over a network. Appellant believes that examiner combines Freeman and Franco only in order to add the user ID to Freeman. Appellant's understanding of the Examiner's reasoning is based on the Examiner's statement that:

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franco invention into of Freeman et al. invention in order to store a user requested program at the user station.

Appellant disagrees with the Examiner's reasoning. Freeman is only concerned with creating and distributing enhanced content for the users of a service provider. Appellant can see no basis for introducing the additional feature of a remote user logging into a web site to remotely control his DVR other than the patent mentions a user ID. However, Freeman is silent in regard to remote operation of the DVR. Freeman has a recording feature. Freeman does not have a remote capability. Indeed, no remote capability is required in Freeman because the DVR / Receiver is local to the user and therefore no remote login to the DVR of Freeman is required. In addition, Claim 6 does not recite remote operation. In Claim 6 a user ID and a program ID are

provided by the DVR to the service provider for the explicit purpose of requesting additional content from the service provider.

Assuming *arguendo* that Freeman and Franco could be combined by re-engineering Freeman's receiver and service provider to support Franco's features. The combined invention would still not teach the claim elements of the Appellant. Specifically, in such a case, the request to record the video would come from a remote computer using Franco's user ID, and then Freeman's service provider would receive the request and distribute the custom program to the user's DVR. Such a merger of the inventions of Freeman and Franco would still fail to teach the novel aspect of Claim 6 as discussed above because the combination is silent in regard to the DVR sending a request when it stores a program, and the service provider sending local marketing content based on a user location and program ID.

#### **4. Claim 7**

Claim 7 recites:

The method of claim 6 further comprising: responsive to a determination by the service provider that the local marketing content does not exist, receiving a message from the service provider at the DVR indicating that there is not any local marketing content.

The Examiner rejects claim 7 for the same reasons as claim 2. However, claim 7 is not identical to claim 2. In regard to claim 2 the Examiner cited Freeman [0028] to disclose "responsive to a determination that no local marketing content exists for the television program." Freeman [0028] discloses selective storing of customized programming. As explained above, Freeman [0028] is silent in regard to a "determination that no local marketing content exists for the television program." Moreover, claim 7 specifies that the determination is made by a service provider, and that the message is from the service provider and the cited art is silent in regard to a service provider.

In regard to claim 2, the Examiner further cited Freeman [0028] and Franco [0090] to disclose "sending a message indicating that no local marketing content exists for the television program to the DVR." Franco [0090] is cited to disclose a DVR. As explained above, the combination of Franco and Freeman is silent in regard to sending message indicating that no local marketing content exists for the television program because, as stated above, Freeman



[0028] is silent in regard to a “determination that no local marketing content exists for the television program” and therefore, the combined art cannot disclose the element of the claim. Moreover, claim 7 specifies that the determination is made by a service provider, and that the message is from the service provider and the cited art is silent in regard to a service provider.

## **5. Claim 12**

Claim 12 recites:

An apparatus, comprising:

- a Digital Video Recorder (DVR) connected to a network;
- a storage medium in the DVR;
- a plurality of instructions stored in the storage medium, configured to run on a processor of the DVR to perform actions comprising:
  - receiving a television program containing an original marketing content from a the service provider;
  - storing the television program in the memory;
  - responsive to the processor storing the television program in the memory, sending, by the processor, a user ID and a program ID to the service provider;
  - responsive to receiving a local marketing content from the service provider at DVR,
  - creating a modified marketing content by modifying the original marketing with the local marketing content, wherein the local marketing content is selected based on a location of the user determined by referencing a user profile associated with the user ID and on the program ID; and
  - displaying the television program with the modified marketing content upon a user request.

Appellant submits that the cited art, individually or in combination, fails to teach or disclose the element “creating a modified marketing content by modifying the original marketing with the local marketing content, wherein the local marketing content is selected based on a location of the user determined by referencing a user profile associated with the user ID and on the program ID.” In rejecting claim 12, the Examiner states “[c]laims 12-22 are rejected for the same subject matter as claims 1-11 respectively.” Thus the examiner has not addressed the language of claim 12 which states “modifying the original marketing with the local marketing content.” Appellant submits that the cited art is silent in regard to “modifying the original marketing content” along with the other elements are recited in the claim.

## **6. Claim 17**

Claim 17 recites;

An apparatus, comprising:  
a processor of a service provider connected to a network;  
a storage medium connected to the processor; a plurality of instructions stored in the storage medium, the plurality of instructions configured to run on the processor to perform actions:  
receiving a user ID and a program ID from a DVR, wherein the user ID and the program ID are sent by the DVR to the processor when the DVR receives a television program and stores the television program in a memory of the DVR;  
determining, by the processor, a location of a user based on a user profile associated with the user ID;  
determining, by the processor, whether a local marketing content exists for the television program based on the program ID and the user profile;  
and  
responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

Appellant submits that the cited art, individually or in combination, fails to teach or disclose the element “responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program” because the limitation requires that the service provider processor receive the user ID and the program ID before sending local marketing content. Thus, when the IDs are received, the local marketing content is sent automatically (“responsive to”) to the DVR. This feature is not found in any of the cited art, nor can it be carried out by a combination of any of the cited art.

## **7. Claim 18**

Claim 18 recites:

The apparatus of claim 17 further comprising: responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

The Examiner rejects claim 18 for the same reasons as claim 2. However, claim 18 is not identical to claim 2. In regard to claim 2 the Examiner cited Freeman [0028] to disclose

“responsive to a determination that no local marketing content exists for the television program.”

Freeman [0028] discloses selective storing of customized programming. As explained above, Freeman [0028] is silent in regard to a “determination that no local marketing content exists for the television program.” In regard to claim 2, the Examiner further cited Freeman [0028] and Franco [0090] to disclose “sending a message indicating that no local marketing content exists for the television program to the DVR.” Franco [0090] is cited to disclose a DVR. Therefore, as explained above, the combination of Franco and Freeman is silent in regard to sending message indicating that no local marketing content exists for the television program because, as stated above, Freeman [0028] is silent in regard to a “determination that the local marketing content does not exist” and therefore, the combined art cannot disclose the element of the claim.

## **B. CONCLUSION**

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellant requests that the Board direct the examiner to allow the claims.

Date: August 30, 2010

Respectfully submitted,

/Rudolf O. Siegesmund/

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## **CLAIMS APPENDIX**

The text of the claims involved in the appeal is as follows:

1. A method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:  
  
    sending, by a processor of a service provider, a television program containing the original marketing content from the service provider, to a DVR;  
  
    receiving, by the processor, a user ID and a program ID from the DVR; and  
  
    responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program ID.
2. The method of claim 1 further comprising:  
  
    determining whether no local marketing content exists for the television program; and  
  
    responsive to a determination that no local marketing content exists for the television program, sending a message indicating that no local marketing content exists for the television program to the DVR.
3. The method of claim 1 wherein the local marketing content is add-on marketing content.

4. The method of claim 1 wherein the local marketing content is a replacement marketing content.

5. The method of claim 1 the local marketing content is an overlay marketing content.

6. A method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:

responsive to a processor of the DVR storing a television program having the marketing content, in the memory, sending, by the processor of the DVR, a user ID and a program ID to a service provider;

responsive to receiving, by the processor, a local marketing content from a service provider in response to sending the user ID and the program ID, replacing the marketing content with the local marketing content in the memory

7. The method of claim 6 further comprising: responsive to a determination by the service provider that the local marketing content does not exist, receiving a message from the service provider at the DVR indicating that there is not any local marketing content.

8. The method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with an information stored in a user profile associated with the user ID.

9. The method of claim 8 wherein the local marketing content is an add-on marketing content.
10. The method of claim 8 wherein the local marketing content is a replacement marketing content.
11. The method of claim 8 wherein the local marketing content is an overlay marketing content.
12. An apparatus, comprising:
- a Digital Video Recorder (DVR) connected to a network;
  - a storage medium in the DVR;
  - a plurality of instructions stored in the storage medium, configured to run on a processor of the DVR to perform actions comprising:
    - receiving a television program containing an original marketing content from a the service provider;
    - storing the television program in the memory;
    - responsive to the processor storing the television program in the memory, sending, by the processor, a user ID and a program ID to the service provider;
    - responsive to receiving a local marketing content from the service provider at DVR, creating a modified marketing content by modifying the original marketing with the local marketing content, wherein the local marketing content is selected based on a location of the user

determined by referencing a user profile associated with the user ID and on the program ID; and  
displaying the television program with the modified marketing content upon a  
user request.

13. The apparatus of claim 12 further comprising:

determining whether a message indicating that no local marketing content exists for the  
television program has been received; and

responsive to a determination that the message indicating that no local marketing content  
exists for the television program has been received, displaying the television program with the  
original marketing content upon the user request.

14. The apparatus of claim 12 further comprising:

responsive to a determination that the local marketing content has been received,  
determining whether the local marketing content is add-on marketing content; and

responsive to the determination that the local marketing content is add-on marketing  
content, creating the modified marketing content by adding the add-on marketing content into the  
television program without modifying the substance of original marketing content.

15. The apparatus of claim 12 further comprising:  
responsive to a determination that a local marketing content has been received,  
determining whether the local marketing content is a replacement marketing content; and  
responsive to the determination that the local marketing content is the replacement  
marketing content, creating the modified marketing content by replacing the original marketing  
content with the replacement marketing content.
16. The apparatus of claim 12 further comprising:  
responsive to a determination that a local marketing content has been received,  
determining whether the local marketing content is an overlay marketing content; and  
responsive to the determination that the local marketing content is the overlay marketing  
content, creating the modified marketing content by placing the overlay marketing content over  
the original marketing content.
17. An apparatus, comprising:  
a processor of a service provider connected to a network;  
a storage medium connected to the processor;  
a plurality of instructions stored in the storage medium, the plurality of instructions  
configured to run on the processor to perform actions:  
receiving a user ID and a program ID from a DVR, wherein the user ID and the  
program ID are sent by the DVR to the processor when the DVR receives a television program  
and stores the television program in a memory of the DVR;



determining, by the processor, a location of a user based on a user profile associated with the user ID;

determining, by the processor, whether a local marketing content exists for the television program based on the program ID and the user profile; and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

18. The apparatus of claim 17 further comprising: responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

19. The apparatus of claim 17 wherein the location of the user is determined by cross-referencing the user ID with an information stored in a user profile and associated with the user ID.

20. The apparatus of claim 17 wherein the local marketing content is an add-on marketing content.

21. The apparatus of claim 17 wherein the local marketing content is a replacement marketing content.

22. The apparatus of claim 17 wherein the local marketing content is an overlay marketing content.

## **EVIDENCE APPENDIX**

This appeal brief presents no additional evidence.

## **RELATED PROCEEDINGS APPENDIX**

This appeal has no related proceedings.